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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ALAN B. NEWMAN and NOOR A. MENAI

Appeal 2016-006297
Application 13/087,053¹
Technology Center 3600

Before ELENI MANTIS MERCADER, LARRY J. HUME, and
SCOTT B. HOWARD, *Administrative Patent Judges*.

HOWARD, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Final Rejection of claims 1, 10, and 20–31, which constitute all of the claims pending in this application. Claims 2–9 and 11–19 have been cancelled. App. Br. 20, 21 (Claims App’x). We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ Appellants identify Citicorp Development Center, Inc. as the real party in interest. App. Br. 1.

THE INVENTION

The disclosed and claimed invention is directed to a system and method for “analyzing marketing efforts. More particularly, the present invention relates to a system and method for evaluating the cause and effect of advertising and marketing programs using card transaction data.” Spec.

¶ 3.

Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A system comprising:
 - a transaction database configured to store card transaction data regarding purchases made with a transaction card at a point-of-sale received from a transaction card issuer company and to filter the input transaction data based on predetermined filtering business rules to determine an information need requested by a client computing device;
 - a customer information database configured to store information identifying card holders;
 - wherein the transaction database is coupled to and interacts with the customer information database to associate the identification information with the card transaction data;
 - a market insights resources server comprising;
 - an analytical module coupled to and interacting with the transaction information database and the customer information database;
 - wherein analysis by the analytical module includes summarizing detailed transaction data on the customers, linking customer data with external datasets, and clustering similar customers into a plurality of segments, wherein each segment comprises customers having at least one common attribute and wherein each segment comprises an identified buying behavior;
 - a reporting module configured to provide a report based on the analysis of the analytical module, including identifying a sales effect of a campaign, market share based on a geographic segment, demographics of a

company's customers, or shopping habits of the company's customers;

a panel card component configured to generate a questionnaire containing a plurality of questions that are based on the information need requested by the client computing device for completion on a website on a customer computing device by a plurality of customers who opted-in to respond to a questionnaire and are selected for the questionnaire based upon a previous transaction, wherein the questionnaire comprises a plurality of questions associated with customer buying behavior at the point-of-sale not limited to a single transaction, wherein the panel card component is coupled to the transaction database and the customer information database which receive a response to the questionnaire transmitted from the customer computing device; and

a value shopper component coupled to the reporting module, the customer information database and the transaction database and are configured to receive an identification of potential customers based upon the questionnaire, the response to the questionnaire, and the report.

REFERENCES

The prior art relied upon by the Examiner as evidence in rejecting the claims on appeal is:

Dejaeger	US 6,456,981 B1	Sept. 24, 2002
Blume	US 6,839,682 B1	Jan. 4, 2005
Boyd	US 7,072,848 B2	July 4, 2006
Smith	US 7,337,127 B1	Feb. 26, 2008

REJECTIONS

Claims 1, 10, and 20–31 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to patent-ineligible subject matter. Final Act. 5–6.

Claims 1, 10, and 20–31 stand rejected under pre-AIA 35 U.S.C. § 112 first paragraph as failing to comply with the written description requirement. Final Act. 7.

Claims 1, 10, 20, 21, 24, 25, and 28–31 stand rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Blume in view of Dejaeger and Smith. Final Act. 8–19.

Claims 22, 23, 26, and 27 stand rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Blume in view of Dejaeger, Smith and Boyd. Final Act. 20–22.

ANALYSIS

We have reviewed the Examiner’s rejection in light of Appellants’ arguments that the Examiner erred. In reaching this decision, we have considered all evidence presented and all arguments made by Appellants. We are not persuaded by Appellants’ arguments regarding the rejections under sections 101 and 112, first paragraph. However, we are persuaded by Appellants’ arguments that the Examiner erred in rejecting the claims under section 103 based on the current record.

Section 101 Rejection

Patent-eligible subject matter is defined in § 101 of the Patent Act, which recites:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

There are, however, three judicially created exceptions to the broad categories of patent-eligible subject matter in § 101: laws of nature, natural phenomena, and abstract ideas. *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134

S. Ct. 2347, 2354 (2014); *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 70–71 (2012). Although an abstract idea, itself, is patent-ineligible, an application of the abstract idea may be patent-eligible. *Alice*, 134 S. Ct. at 2355. Thus, we must consider “the elements of each claim both individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application.” *Id.* (citing *Mayo*, 132 S. Ct. at 1297–98). The claim must contain elements or a combination of elements that are “sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [abstract idea] itself.” *Id.* (citing *Mayo*, 132 S. Ct. at 1294).

The Supreme Court set forth a two-part “framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Id.* at 2355.

First, we determine whether the claims at issue are directed to one of those patent-ineligible concepts. [*Mayo*,] 132 S. Ct., at 1296–1297. If so, we then ask, “[w]hat else is there in the claims before us?” *Id.*, at —, 132 S. Ct., at 1297. To answer that question, we consider the elements of each claim both individually and “as an ordered combination” to determine whether the additional elements “transform the nature of the claim” into a patent-eligible application. *Id.*, at —, 132 S. Ct., at 1298, 1297. We have described step two of this analysis as a search for an “‘inventive concept’”—*i.e.*, an element or combination of elements that is “sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.” *Id.*, at —, 132 S. Ct., at 1294.

Alice, 134 S. Ct. at 2355.

“The ‘abstract idea’ step of the inquiry calls upon us to look at the ‘focus of the claimed advance over the prior art’ to determine if the claim's

‘character as a whole’ is directed to excluded subject matter.” *Affinity Labs of Tex. v. DirectTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016) (quoting *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016)); *see also Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016). There is no definitive rule to determine what constitutes an “abstract idea.” Rather, the Federal Circuit has explained that “both [it] and the Supreme Court have found it sufficient to compare claims at issue to those claims already found to be directed to an abstract idea in previous cases.” *Enfish*, 822 F.3d 1327, 1334 (Fed. Cir. 2016); *see also Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016) (explaining that, in determining whether claims are patent eligible under § 101, “the decisional mechanism courts now apply is to examine earlier cases in which a similar or parallel descriptive nature can be seen—what prior cases were about, and which way they were decided”).

The Examiner concludes the claims are directed to the abstract idea of “providing marketing insights based upon transaction data and customer questionnaire.” Final Act. 5; *see also* Ans. 5 (“As noted in the Final Action, the independent claims are directed to providing marketing insights based upon transaction data and customer questionnaire. This is a means of organizing information through mathematical correlations and thus an idea in itself and thus an abstract idea . . .”). The Examiner further concludes that “[t]his is not only a long-standing, fundamental economic practice (merchants have long been analyzing who is buying what and asking about customers’ preferences) but also employing mathematical algorithms to manipulate existing information to generate additional information, and thus an abstract idea.” Final Act 5; *see also* Ans. 6–7 (“Providing marketing

insights based upon transaction data and customer questionnaire is also a method of organizing human activity because, like intermediated settlement and risk hedging, receiving transaction and customer data, analyzing the received data, generating marketing-related reports based on the analysis, and generating a questionnaire are long-standing commercial practices and thus comprise an abstract idea”). Applying the July 2015 Guidelines, the Examiner concludes the claims are similar to the claims in *Planet Bingo, LLC v. VKGS LLC*, 576 Fed. Appx.1005 (Fed. Cir. 2014), *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1372 (Fed. Cir. 2011)), and *In re Maucorps*, 609 F.2d 481 (CCPA 1979). Ans. 6–7.

Appellants argue the claims are not directed to an abstract idea. App. Br. 6–8; Reply Br. 4–8. Specifically, Appellants argue the claims “are ‘necessarily rooted in computer technology,’ as in *DDR*,^[2] *supra*, because they necessarily require a special-purpose computer rather than a generic computer. Indeed, the fact that a claim can be implemented using generic or general-purpose computer equipment is not conclusive in making a Section 101 rejection.” App. Br. 6. Replying on *In re Alappat*, 33 F.3d 1526, 1545 (Fed. Cir. 1994) (en banc), Appellants argue because the claims “necessarily require a special-purpose computer rather than a generic computer” and “[a] specifically programmed general-purpose computer is in fact a special-purpose computer, provided that the claim requires specific programming,” the claims are not directed to an abstract idea. App. Br. 6.

Appellants also argue the Examiner erred because the Final Action did not follow the July 2015 Guidelines, which, according to Appellants,

² *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014).

“instruct that the Examiner is not to identify a claimed concept as an abstract idea ‘unless it is similar to at least one concept that the courts have identified as an abstract idea.’” App. Br. 8.

In the Reply Brief, Appellants argue, relying on *Enfish*,³ the claims are not abstract because “the claims focus on the functioning of the computing technology, instead of focusing on some pre-Internet process for which the computing device just happens to be used as a tool for implementation.” Reply Br. 4; *see also id.* at 6 (arguing “the claims are intended to focus on the functioning of the computing technology, as opposed to some pre-Internet business process”). Instead, Appellants argue “the claims recite computer technology features that provide an improved (more effective) system for analyzing card transaction data and evaluating transaction data. In other words, the claims are not so much directed to some broadly-stated idea implemented on a computer, but rather the claims focus on the computer functioning.” *Id.* at 6.

We are not persuaded by Appellants’ arguments. Instead, we agree with and adopt the Examiner’s findings and conclusion that the claims are directed to an abstract idea. Specifically, Appellants’ reliance on *Alappat* is misplaced as the Federal Circuit has held “that *Alappat* has been superseded by *Bilski* [v. Kappos, 561 U.S. 593, 605–06 (2010)], and *Alice*.” *Eon Corp. IP Holdings LLC v. AT&T Mobility LLC*, 785 F.3d 616, 623 (Fed. Cir. 2015).

³ Although Appellants did not provide a basis for making this new argument in the Reply Brief, we find good cause to consider the argument in light of the Federal Circuit issuing the *Enfish* decision in the period between the opening and reply briefs. *See* 37 C.F.R. § 41.41(b)(2).

Nor are we persuaded by Appellants' argument directed to the 2015 Guidelines. First, the USPTO guidelines are not legal requirements. *Cf. In re Fisher*, 421 F.3d 1365, 1372 (Fed. Cir. 2005) ("The MPEP and Guidelines 'are not binding on this court.'") (citations omitted). Instead, we are bound by Supreme Court and Federal Circuit decisions construing the scope of the judicial exception. Second, the Final Action was issued in June 2015, before the promulgation of the July 2015 Guidelines. Accordingly, the Examiner could not have applied them in the Final Action. Third, following the promulgation of the July 2015 Guidelines, the Examiner followed them and identified cases in which the Federal Circuit found similar claims to be patent-ineligible. Moreover, we are not persuaded by Appellants' arguments the Examiner erred in finding the claims in those cases similar to the pending claims. Instead, we agree with and adopt the Examiner's determination that the claims do not more than recite routine computer elements. *See* Ans. 3–4.

Finally, we are not persuaded by Appellants' arguments that the pending claims are similar to those found to be directed to patent-eligible subject matter in *Enfish* and *DDR*. First, as our reviewing court held in *DDR*, "not all claims purporting to address Internet-centric challenges are eligible for patent." 773 F.3d at 1258. As the Federal Circuit recognized:

For example, in our recently-decided *Ultramercial*⁴ opinion, the patentee argued that its claims were "directed to a specific method of advertising and content distribution that was previously unknown and never employed on the Internet before." 772 F.3d at 714. But this alone could not render its

⁴ *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709 (Fed. Cir. 2014), *vacated and remanded*, *Wildtangent, Inv. v. Ultramercial LLC*, 134 S. Ct. 2870 (2014) (remanding for consideration in light of *Alice*, 134 S. Ct. 2347).

claims patent-eligible. In particular, we found the claims to merely recite the abstract idea of “offering media content in exchange for viewing an advertisement,” along with “routine additional steps such as updating an activity log, requiring a request from the consumer to view the ad, restrictions on public access, and use of the Internet.” *Id.* at 715–16.

Id. Because Appellants have merely identified routine additional steps, they are insufficient to render the claims patent-eligible.

Moreover, we disagree with Appellants that the claims in this case are directed to a computer-centric problem similar to that in *DDR*. In *DDR*, the Court found that the claims “do not merely recite the performance of some business practice known from the pre-Internet world along with the requirement to perform it on the Internet. Instead, the claimed solution is necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks.” *Id.* at 1257. Unlike the claims in *DDR*, we agree with and adopt the Examiner’s determination that the claims in this case are merely adopting a pre-existing business practice for use with computer technology.

Although Appellants state the claims are directed to computer functions and not “to some broadly-stated idea implemented on a computer,” Reply Br. 6, Appellants do nothing more than recite the claim language without explaining how it is directed to computer functions. That is not sufficient to show that the Examiner erred. Moreover, Appellants’ argument is inconsistent with the language recited in the claims, which focuses on results, and not how those results are achieved. *See* App. Br. 19–23 (Claims App.). Although the claimed system and method may be more efficient than prior art, non-computer solutions, that is not enough to make the claims patent-eligible:

While the claimed system and method certainly purport to accelerate the process of analyzing audit log data, the speed increase comes from the capabilities of a general-purpose computer, rather than the patented method itself. *See Bancorp Servs., L.L.C. v. Sun Life Assurance Co. of Can. (U.S.)*, 687 F.3d 1266, 1278 (Fed. Cir. 2012) (“[T]he fact that the required calculations could be performed more efficiently via a computer does not materially alter the patent eligibility of the claimed subject matter.”).

FairWarning IP, LLC v. Iatric Sys., Inc., 839 F.3d 1089, 1095 (Fed. Cir. 2016).

Turning to step 2 of the framework, the Examiner also concludes the claims do not recite something more than the abstract idea. Final Act. 5–6; Ans. 8–9. Specifically, the Examiner determines the various elements cited by Appellants are claimed and described “at a high level of generality which may be implemented via a general purpose computer system and which encompass elements that are well-understood, routine, and conventional. Thus, the computing elements do not, in themselves or in combination, amount to significantly more than the judicial exception.” Ans. 8.

Appellants argue the claims are directed to something more because the claims do not monopolize or tie-up the abstract idea. App. Br. 8–10. Appellants further asserts the claims are similar to example 23 of the July 2015 guidelines, which was deemed patent-eligible:

Similar to Example 23, claim 4 above, independent claims 1 and 10, when read as a whole, disclose numerous computing elements that are specifically selected and integrated in select ways to perform particular claim functions — which is significantly more than the concept of “providing marketing insights based upon transaction data and customer questionnaire.”

App. Br. 12; *see also* Reply Br. 8–9. According to Appellants, the combination “provides a more effective system and method for analyzing card transaction data and evaluating the effect of marketing programs using card transaction data.” *Id.* at 13.

We are not persuaded by Appellants’ arguments the Examiner erred. Instead, we agree with the Examiner that the claims do not recite significantly more than the abstract idea itself.

With regard to Appellants’ preemption argument, although the extent of preemption is a consideration, the absence of complete preemption is not dispositive. *See, e.g., Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) (“While preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.”); *Ultramercial*, 722 F.3d at 1346 (“[T]he Supreme Court has stated that, even if a claim does not wholly pre-empt an abstract idea, it still will not be limited meaningfully if it contains only insignificant or token pre- or post-solution activity—such as identifying a relevant audience, a category of use, field of use, or technological environment.”) (citations omitted). Accordingly, even if the claims do not—to use Appellants’ words—tie-up or monopolize the abstract idea, that alone is not enough to render the claims patent-eligible.

Second, similar to the reasons discussed above regarding the abstract idea, we are not persuaded by Appellants’ assertions that the claims are similar to those found patent-eligible in *Enfish* and *DDR*. Although Appellants recite the claim limitations, Appellants do not explain persuasively how those elements are more than generic and conventional computer elements that, when considered either individually and

collectively, are something more than the abstract idea. Using a “computer server and code implemented in software”—a generic computer component—to perform a method does not impart patentability. Our reviewing court “found similar claims to be ineligible despite the recitation of a general purpose computer or the Internet.” *Versata Dev. Grp., Inc. v. SAP Am., Inc.*, 793 F.3d 1306, 1334 (Fed. Cir. 2015) (collecting cases). As in *Versata*, the claims here “do not improve some existing technological process or solve some technological problem in conventional industry practice.” *Id.* Similarly,

[T]he claims at issue are not rooted in computer technology to solve a problem specifically arising in some aspect of computer technology. Instead, the claims at issue are more like the claims we summarized in *DDR Holdings* as insufficient to reach eligibility—claims reciting a commonplace business method aimed at processing business information despite being applied on a general purpose computer.

Id.; see also *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1373–77 (Fed. Cir. 2011) (merely using a computer readable medium is not sufficient to transform an abstract idea to patentable subject matter); see also *Ultramercial*, 772 F.3d 709 (finding a method for distribution of products over the Internet directed to unpatentable under the *Alice/Mayo* framework).

Accordingly, we sustain the Examiner’s rejection of claims 1, 10, and 20–31 as directed to patent-ineligible subject-matter.

Section 112, First Paragraph Rejection

The Examiner finds the Specification does not provide written description support for the “questions associated with customer buying behavior at the point-of-sale” limitation recited in claims 1 and 10. Final

Act. 7.⁵ More specifically, the Examiner finds why the various paragraphs cited by Appellants do not provide sufficient support for the limitation. Ans. 10–11.

Appellants assert the Examiner erred in rejecting the claims for a lack of written description support. App. Br. 10. The entirety of Appellants’ assertion is as follows: “The specification also provides exemplary support for ‘questions associated with customer buying behavior at the point-of-sale’ (POS) in at least paragraphs [0082], [0130], [0135], [0159], and [0164].” *Id.* at 13; *see also* Reply Br. 9 (“With respect to the remaining and related rejections under 35 U.S.C. § 112, Appellant reasserts the positions proffered in the related portions of the Appeal Brief, and maintains that the features recited by the claims are supported in the application as originally filed.”).

To satisfy the written description requirement, the disclosure must reasonably convey to skilled artisans that Appellant possessed the claimed invention as of the filing date. *See Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). Specifically, the description must “clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.” *Id.* (alteration in original) (quoting *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991)).

[T]he test requires an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art. Based on that inquiry, the specification must

⁵ The Examiner also found that the Specification did not support the “client computing device” limitation recited in the claims. Final Act. 7. The Examiner withdrew that portion of the rejection in the Answer. Ans. 10. Accordingly, we do not review that portion of the rejection in this Decision.

describe an invention understandable to that skilled artisan and show that the inventor actually invented the invention claimed.

Id. The claimed invention need not be recited *in haec verba* in the original specification in order to satisfy the written description requirement. *Id.* at 1352.

We are not persuaded by Appellants assertion that the Examiner erred. Although Appellants cite to various paragraphs in the Specification as support for the disputed limitation, Appellants do not explain how those paragraphs provide a written description for the limitation. Nor do Appellants address the Examiner's findings in the Answer as to why those paragraphs do not provide support. In light of the Examiner's detailed findings, which we agree with and adopt herein as our own, Appellants' bare assertion that a combination of various disparate paragraphs provide written description support is not persuasive.

Accordingly, we sustain the Examiner's rejection of claims 1, 10, and 20–31 under 35 U.S.C. § 112, ¶ 1.

Section 103(a) Rejections

The Examiner finds Smith teaches “a panel card component *configured to generate a questionnaire* containing plurality of questions that are based on the information need requested by the client computing device for completion on a website on a customer computing device *by a plurality of customers who opted-in to respond to a questionnaire and are selected for the questionnaire based upon a previous transaction,*” as recited in claim 1. Final Act. 12–13; Ans. 13–14. Specifically, the Examiner construes the limitation as requiring “the selection of customers that is based upon a previous transaction and not the questionnaire as suggested by the

Appellant.” Ans. 13. The Examiner finds Smith teaches the selection of customers for questionnaires based on the user profile and that the user profile includes previous transactions:

Smith teaches that the selection of customers for the context-specific surveys based upon the profile (col. 6, 48-54) which includes purchasing history (col. 7, lines 32-33), and purchasing history inherently includes previous purchase transactions or it is not a purchasing history. Since the selection is based upon the profile which includes previous purchase transactions, the selection is based, at least in part, on previous transactions.

Id. at 14.

Appellants argue the Examiner erred in finding Smith teaches the disputed limitation. App. Br. 16. Specifically, Appellants argue Smith teaches selecting people for questions, along with the content of the questions, based on missing data in the user profile, not a previous transaction:

Instead, Smith generates a questionnaire to complete a user profile. As cited by the Examiner, Smith recites “user registration includes the creation of a user profile, which is used by the Web server to store data associated with the registered user.” Col. 2, lines 23-25. “[T]he market researcher is prompted to develop a context-specific survey question that relates to the content, the *answer to which supplies the deficient data element*. For example, if a user is browsing for a pair of shoes, a question asking for the user’s shoe size (i.e., the deficient data in this example) would appear to the user a helpful shoe finding aid, while providing the deficient data about the user.” Col. 6, line 61 - Col. 7, line 1 (emphasis added). Creating a survey question based on a user profile that contains deficient data (i.e., user’s shoe size) is not opting-in to respond to a questionnaire based upon a previous transaction. Thus, Smith recites responding to a questionnaire based on

data, which is deficient in the user's profile, and not based on previous transactions.

Id.; *see also* Reply Br. 10 (arguing that “Smith recites that the context specific survey pertains to a deficiency in the user profile data of a particular user. *See e.g.* Smith at col. 6, line 64-col. 7, line 1 (asking for a particular user's shoe size)”).

We are persuaded by Appellants' arguments as the Examiner has not identified sufficient evidence or provided sufficient explanation as to how Smith teaches or suggests the disputed limitation. Although Smith teaches that the selection for questions, along with the contents of the question, is based on a portion of the user profile and that the user profile contains, *inter alia*, prior purchase history, the Examiner has not shown sufficiently that Smith teaches using the purchase history in selecting the people for receiving the questionnaire. For example, as explained by Appellants, the specific sections cited by the Examiner refer to asking questions of people to complete their profile, not based on prior purchases. Accordingly, we agree with Appellants that the Examiner's finding that Smith teaches the disputed limitation is in error because it is not supported by a preponderance of the evidence. *See In re Caveney*, 761 F.2d 671, 674 (Fed. Cir. 1985) (Examiner's burden of proving non-patentability is by a preponderance of the evidence); *see also In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967) (“The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not, because it may doubt that the invention is patentable,

resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.”).⁶

Accordingly, we are constrained on this record to reverse the Examiner’s rejection of claim 1, along with the rejections of claim 10, which recites limitations commensurate in scope to the disputed limitation discussed above, and dependent claims 20, 21, 24, 25, and 28–31.

Moreover, because the Examiner has not shown that Boyd or the Official Notice cures the foregoing deficiencies regarding the rejection of the independent claims, we do not sustain the obviousness rejection of dependent claims 22, 23, 26, and 27 (Final Act. 20–22) for similar reasons.

DECISION

For the above reasons, we affirm the Examiner’s decisions rejecting claims 1, 10, and 20–31 as unpatentable under sections 101 and 112, first paragraph.

For the above reasons, we reverse the Examiner’s decisions rejecting claims 1, 10, and 20–31 as unpatentable under section 103.

Because we affirm at least one ground of rejection with respect to each claim on appeal, we affirm the Examiner’s decision to reject all of the pending claims.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv). *See* 37 C.F.R. § 41.50(f).

⁶ Appellants raise additional issues in the Appeal Brief. Because we are persuaded the Examiner erred with respect to this dispositive issue, we do not reach the additional issues.

Appeal 2016-006297
Application 13/087,053

AFFIRMED